UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,047	08/28/2001	Umair A. Khan	CLICP008	7341

			EXAMINER
28875	7590	06/14/2006	HARBECK, TIMOTHY M

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ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

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<td rowspan="2">Office Action Summary</td>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 August 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>01/18/2002</u>. \v/21/2002

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-30 and 31 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Software, programming, instructions or code not claimed as encoded on computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

Claim 31 is therefore rejected where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a

computer. Examiner suggests that the applicant incorporate into Claim 31 language

that the proposed software is recorded on computer-readable medium and capable of

execution by a computer to overcome this rejection.

Correction required. See MPEP § 2106 [R-2]..

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14, 33-39 and 41 are rejected under 35 U.S.C. 102(e) as being

anticipated by Adam et al (hereinafter Adam, US 2002/0069164 A1).

Re Claim 1: Adam discloses a method for carrying out a computer-implemented

transaction comprising:

- Storing in memory a transaction pattern reflecting a transaction (Page 1

    paragraph 0001-0003)

- Executing the transaction pattern to carry out the transaction (Page 1,

    paragraph 0002, last sentence)

Re Claim 2: Adam discloses the claimed method supra and further discloses

wherein the transaction pattern includes a record of:

- Information submitted by a user (i.e. previous bill of materials)

- User actions taken by the user (paragraph 0028, "identification information

  provided by the user.")

- System actions taken by a system in response to the information and the

  user actions in order to generate results (paragraph 0028 "server

  compares the user provided information with to the pre-stored

  information...") and

- The results that are sent to the user (paragraph 0003 "If at least one bill of

  materials matches the received user criteria for the bill of material, the pre-

  stored bill of material information is downloaded for communication to the

  user).

Re Claim 3: Adam discloses the claimed method supra and further discloses

wherein the transaction pattern includes a record of actions taken by the system which

enable access of the user to data (paragraph 0028 "server then receives identification

information from the user and retrieves a selected project from a database resident on

server.)

Re Claim 4: Adam discloses the claimed method supra and further discloses

wherein the transaction pattern includes the storage of records relating to a user

interface presented to a user (paragraph 0042, Fig 15; screen shot is a saved interface

previously presented to a user).

Re Claim 5: Adam discloses the claimed method supra and further discloses

wherein the transaction pattern includes the storage of records relating to the

submission of information by a user (paragraph 0002; "retrieve a previously generated

bill of material").

Re Claim 6: Adam discloses the claimed method supra and further discloses

wherein the transaction pattern includes the storage of parameters required to complete

the transaction (paragraph 0028 "The pre-stored information includes various types of

bill of material related information.")

Re Claim 7: Adam discloses the claimed method supra and further discloses

wherein the transaction pattern includes the storage of records relating to the navigation

of a user during the transaction (paragraphs 0001-0003, 0028; the storage of the

previous bill of material is a storage of the navigation that the user used to create the

file. See paragraphs 0030-0038 show the navigation steps used to create a bill of

material, which is later saved).

Re Claim 8: Adam discloses the claimed method supra and further discloses

wherein the transaction pattern includes the storage of information returned to a user by

a system (paragraph 0003; pre-stored bill of materials is returned to the user by the

system, where it can be further edited or simply re-submitted)

Re Claim 9: Adam discloses the claimed method supra and further discloses

wherein the transaction pattern includes the storage of information selected by the user

(paragraph 0039; "the system brings the user back to the product selection page

preconfigured according to the product that the user wants to edit.")

Re Claim 10: Adam discloses the claimed method supra and further discloses

wherein the execution of the transaction includes retrieval of the transaction pattern by

at least one of an automated agent and a programmable agent (paragraph 0028 "server" is an automated agent).

Re Claim 11: Adam discloses the claimed method supra and further discloses wherein the execution of the transaction includes submission of required parameters during the transaction (paragraph 0028 "The pre-stored information includes various types of bill of material related information.")

Re Claim 12: Adam discloses the claimed method supra and further discloses wherein the execution of the transaction involves automatic navigation during the transaction (paragraph 0028; the presentment of a previously submitted bill of materials is an automatic navigation of the previous steps the user had to perform in order to generate said bill of materials).

Re Claim 13: Adam discloses the claimed method supra and further discloses wherein the execution of the transaction includes retrieval of content (paragraph 0001-0003)

Re Claim 14: Adam discloses the claimed method supra and further discloses wherein the execution of the transaction includes relaying content to a user (paragraph 0001-0003)

Re Claim 33: Adams discloses a method for carrying out a computer implemented transaction comprising:

- Recording information submitted by a user as part of a transaction (previously submitted bill of materials assumes information has been recorded 0003)

- Recording user actions taken by a user as part of the transaction (records original submission of bill of materials for later use; paragraph 0003)

- Recording system actions taken by the system in response to the information and the user actions in order to generate results as part of the transaction;

- Recording the results that are sent to a user as part of the transaction (0042; bill of material is the results that are sent to the user)

- Generating a transaction pattern based on the recorded information (transaction pattern is used to regenerate the previously submitted bill of materials automatically as opposed to manually repeating all tasks; paragraph 0001);

- Storing the transaction pattern in memory (0003; saving user information) and;

- Executing the transaction pattern to automatically carry out the transaction upon receiving a user request for the transaction (0003)

Re Claims 34-39: Previously rejected claims 3, 8-10, 12 and 14 have previously shown that Adams has anticipated these limitations. For the sake of brevity please refer to those respective claims for citation of the prior art.

Re Claim 41: Adams discloses a method for carrying out a computer-implemented electronic commerce (e-commerce) transaction comprising:

- Storing in memory a transaction pattern reflecting a transaction wherein the transaction pattern includes (paragraph 0001-0003)

  o Creation and actions associated with forms presented in a web-interface with which a user submits information (paragraph 0020 "web based;" also see Figs 4-16 for web based screen shots and paragraphs 0028-0043 for creation of bill of material forms)

  o Information submitted by a user, in forms presented in an ecommerce flow (paragraphs 0001 "ecommerce;" see paragraphs 0028-0043 for form creation; specifically paragraph 0039 "Bill of Material Page."

  o An internal process whereby the submitted information is sent to servers and databases of an ecommerce site (0026)

  o Navigation of the user within the e-commerce process (see paragraphs 0028-0043, navigate to create and edit bill of materials)

  o Results returned by the e-commerce site once the submitted information has been processed (paragraph 0042 "recalled bill of material page.")

- Executing the transaction pattern to carry out the transaction (0002 "fulfillment.")

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

<u>Claims 15-32, 40 and 42 are rejected under 35 U.S.C. 103(a) as being</u>

<u>unpatentable over Adam</u>.

Re Claim 15: Adam discloses the claimed method supra but does not explicitly

disclose wherein the execution of the transaction includes recognizing the state of a

remote transaction. However it was well known in the art at the time of invention for

computer related applications to come in a variety of different "states" or formats. It

therefore would have been obvious to anyone of ordinary skill at the time of invention to

allow the method of Adam to determine and recognize a variety of common application

states so that the appropriate content can be pulled and organized from a variety of

sources. If the method of Adam did not perform this step than only some formats would

be recognized and important data may not be forwarded on to the user.

Re Claims 16-30: Further computer program product claims would have been

obvious in order to implement the previously rejected method claims 1-15 respectively

and are therefore rejected using the same art and rationale.

Re Claim 31: Further system claim would have been obvious in order to perform

the previously rejected method claim 1 above and is therefore rejected using the same

art and rationale.

Re Claim 32: Adam discloses the claimed method supra and further discloses wherein the remote application is an electronic commerce application (paragraph 0001)

Re Claim 40: Adam discloses the claimed method supra but does not explicitly disclose wherein the execution of the transaction includes recognizing the state of a remote transaction. However it was well known in the art at the time of invention for computer related applications to come in a variety of different "states" or formats. It therefore would have been obvious to anyone of ordinary skill at the time of invention to allow the method of Adam to determine and recognize a variety of common application states so that the appropriate content can be pulled and organized from a variety of sources. If the method of Adam did not perform this step than only some formats would be recognized and important data may not be forwarded on to the user.

Re Claim 42: Adams has been shown to explicitly or implicitly disclose each limitation of claim 42 in the previously rejected claims 1-15 and 33-41 and therefore claim 42 is rejected using the same rationale as those previous claims. For the sake of brevity the examiner notes the following.

- o (a)-(d) and (g)-(h) of claim 42 are the same as respective parts (a) –
  (g) in claim 33 and therefore the same rationale applies
- o for (e) and (f) see rejection of claim 34
- o for the sub categories of (h)
  - o for (i) see rejection of claim 4
  - o for (ii) see rejection of claim 2
  - o for (iii) see rejection of claim 6

      o for (iv) see rejection of claim 7

      o for (v) see rejection of claim 8

      o for (vi) see rejection of claim 9

   o for the sub categories of (i)

      o for (i) see rejection of claim 10

      o for (ii) see rejection of claim 15

      o for (iii) see rejection of claim 11

      o for (iv) see rejection of claim 12

      o for (v) see rejection of claim 13

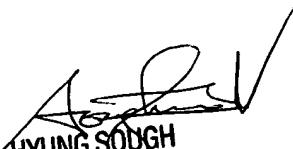   o for (vi) see rejection of claim 14

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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